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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/081,268	02/22/2002	Michael B. Northcott	10018686-1	9852

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EXAMINER	
DESHPANDE, KALYAN K	
ART UNIT	**PAPER NUMBER**
3623	

DATE MAILED: 02/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/081,268	NORTHCOTT ET AL.	
	Examiner	Art Unit	
	Kalyan K. Deshpande	3623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *22 February 2002*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *22 February 2002* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *2/22/2002*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Introduction

1. The following is a non-final office action in response to the communications received on February 22, 2002. Claims 1-20 are now pending in this application.

Information Disclosure Statement

2. The examiner has reviewed the patents and articles supplied in the Information Disclosure Statements (IDS) provided on February 22, 2002.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "relatively high" in claim 4 is a relative term which renders the claim indefinite. The term "relatively high" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Claim 19 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "well-correlated" in claim 4 is a relative term which renders the claim indefinite. The term "well-correlated" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one

of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 1-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claimed invention is required to produce a useful, concrete, and tangible real-world result. An invention that fails to produce a tangible result is one that involves no more than the manipulation of an abstract idea. See *State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 149 F. 3d 1368, 47 USPQ2d 1596 (Fed. Cir. 1998). In order to be concrete the result must be substantially repeatable or the process must substantially produce the same result again.

Claims 1 merely recites the manipulation of an abstract idea and does not produce a concrete result. Claims 1 recites "identifying a potential point of intervention in the process based at least in par upon an analysis of the values associated with the tasks in the process map", which is a mere abstract ideas that does not produce a real-world result. The step of "identifying a potential point of intervention in the process based at least in par upon an analysis of the values associated with the tasks in the process map" is based on subjective standards. The results of this step will not produce concrete real-world results since there is no evidence that this step, when repeated, will produce substantially the same results. This step is based on a subjective standard and

will produce different results for each individual performing the step. Because the results produced by the method are not tangible and concrete, claims 1 is considered to be directed toward non-statutory subject matter.

Claims 2-20 recite subject matter already addressed by the rejection of claims 1 without resolving the concrete and tangible issues; therefore the same rejection applies to these claims.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ulwick (U.S. Patent No. 5963910).

As per claim 1, Ulwick teaches:

A method of identifying potential business opportunities, comprising:

identifying a target customer need state based upon an analysis of marketplace data (see column 5 lines 65-67 and column 6 lines 1-41; where a customer mission (need) is identified based on market research, where the market research can be segmented in various manners.);

generating a map of a process for addressing the identified target customer need state, the process map including a network of tasks each having one or more associated values (see column 8 lines 61-67 and column 9 lines 1-25; where a

process, consisting of tasks and activities, is generated to evaluate the desired outcomes.); and

Ulwick fails to teach:

Identifying a potential point of intervention in the process based on at least in part upon an analysis of the values associated with the tasks in the process map.

Though Ulwick fails to explicitly teach a point of intervention, Ulwick does teach steps in the process that can be performed manual and require human intervention (see column 10 lines 49-67, column 11 lines 16-45, and figures 15 and 17; where manual steps in the mission evaluation are described). The advantages of allowing a user to identify a point of intervention is that it allows the user the ability to select an appropriate time and step for intervention in order to ensure optimization of the process. It would have been obvious, at the time of the invention, for one of ordinary skill in the art to allow a user to identify a potential point of intervention in order to ensure optimization of the process, which is a goal of Ulwick (see column 2 lines 40-42).

As per claim 2, Ulwick teaches:

The method of claim 1, wherein identifying a target customer need state comprises scanning marketplace data without foreknowledge of a potential target customer need state (see column 6 lines 25-41; where the market research requires scanning data from marketplace data. The user may or may not have knowledge of the desired outcomes of the customer mission.).

As per claim 3, Ulwick teaches:

The method of claim 1, wherein identifying a target customer need state comprises scanning marketplace data in accordance with a preselected target customer need state (see column 6 lines 25-41; where the market research requires scanning data from marketplace data. The user may have preselected a mission to gather data on.).

As per claim 4, Ulwick fails to teach:

customer need state associated with a relatively high total cost.

Ulwick teaches a identifying a customer needs that requires optimization of critical factors such as resources, time, and costs (see column 6 lines 66-67 and column 7 lines 1-5). The advantages of identifying customer needs of a relatively high total cost is that this identification allows a user to determine which processes to evaluate in order to reduce costs. It would have been obvious, at the time of the invention, for one of ordinary skill in the art to use the Ulwick system to identify processes of high costs in order to determine which processes to evaluate in the Ulwick system to reduce total costs, which is a goal of Ulwick (see column 2 lines 36-42).

As per claim 5, Ulwick teaches:

The method of claim 1, wherein identifying a target customer need state comprises selecting a subset of potential target customer need states and associating with each potential target customer need state a set of one or more tasks (see column 8 lines 33-67 and column 9 lines 1-25; where the targeted improvement is associated with a process, which is broken down in to activities and events.).

As per claim 6, Ulwick teaches:

The method of claim 5, further comprising assigning values to the tasks associated with each of the potential target customer need states (see figures 5 and 6; where values are assigned to potential target customer need states.).

As per claim 7, Ulwick teaches:

The method of claim 6, wherein values for one or more of the following task parameter metrics are assigned to the associated tasks: device downtime, communications from difficult transmission areas, unauthorized use, cost of accessories, customizable features, and cost of replacements (see figures 5 and 6; where task parameter metrics are listed.)

Ulwick fails to teach:

The method of claim 6, wherein values for one or more of the following task parameter metrics are assigned to the associated tasks: a cost metric, an incidence rate metric, and a metric measuring diversity of association with different potential target customer need states.

Ulwick teaches the use of task parameter metrics. Ulwick does not expressly teach the specific metrics recited in claim 7; however, these differences are only found in the non-functional descriptive material and are not functionally involved in the steps recited nor do they alter the recited structural elements. The recited method steps would be performed the same regardless of the specific metrics. Further, the structural elements remain the same regardless of the specific metrics. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of

patentability, *see In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); In re Lowry, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP ∋ 2106.*

As per claim 8, Ulwick teaches:

The method of claim 7, further comprising ranking potential target customer need states in accordance with values assigned to associated tasks (see figures 5 and 6; where potential target customer needs states are prioritized.).

As per claim 9, Ulwick teaches:

The method of claim 1, wherein generating a map of a process for addressing the identified target customer need state comprises identifying a representative process currently addressing the identified target customer need state and generating a map for the representative process (see column 8 lines 61-67 and column 9 lines 1-25; where a process, consisting of tasks and activities, is generated to evaluate the desired outcomes and existing processes are improved.).

As per claim 10, Ulwick teaches:

The method of claim 9, further comprising estimating unit cost values, incidence rates, total costs, and outcomes for each task in the process map generated for the representative process (see column 8 lines 61-67, column 9 lines 1-25, and figures 5, 6, and 9; where a process, consisting of tasks and activities, is generated to evaluate the desired outcomes. The process can consider costs, including replacement costs, device downtimes (incident rates), and outcomes, determined by benchmark comparisons.).

As per claim 11, Ulwick teaches:

The method of claim 10, wherein identifying a potential point of intervention comprises selecting a potential target task from the tasks in the representative process map based at least in part upon one or more of the estimated unit cost values, incidence rates, total costs, and outcomes (see column 10 lines 49-67 and column 11 lines 16-45; where the intervention point can be at the point in the process where predictive metrics are applied.).

As per claim 12, Ulwick teaches:

The method of claim 11, further comprising mapping the potential target task into a network of one or more sub-tasks (see figures 2, 5, 6, and 15-17; where the process is broken down in the sub-processes (sub-tasks). Each sub-task is further broken down in to its elements.).

As per claim 13, Ulwick teaches:

The method of claim 12, further comprising generating a list of one or more projected customer problems based at least in part upon the potential target task mapping (see figures 1-6 and 17; where the ability to select a mission (projected customer problem) is displayed in figure 1. Associated tasks with each mission is described in figure 4.).

As per claim 14, Ulwick teaches:

The method of claim 13, further comprising generating a list of one or more projected customer needs based at least in part upon the projected customer problem list (see figures 2, 5, and 6; where missions (customer problem) are broken down in to requirements (projected customer needs).).

As per claim 15, Ulwick teaches:

The method of claim 14, wherein generating the projected customer needs list comprises identifying customer needs that correspond to business opportunities for reducing cost or improving outcomes, or both (see figures 1-6 and 17; where customer missions are broken down in to requirements to improve outcomes and/or reduce a plurality of costs.).

As per claim 16, Ulwick teaches:

The method of claim 14, further comprising assessing customer value associated with each of the projected customer needs (see figures 2-4 and 17; where the values a customer has for a specific requirement and mission are assessed.).

As per claim 17, Ulwick teaches:

The method of claim 14, wherein generating the projected customer needs list comprises identifying customer needs associated with specific tasks and focused on reducing cost or improving outcomes, or both (see figures 1-6 and 17; where customer missions are broken down in to requirements to improve outcomes and/or reduce a plurality of costs.).

As per claims 18 and 19, Ulwick fails to teach correlating projected customer needs with core competencies and resources and further investigating projected customer needs based on the level of correlation to core competencies and resources. The advantages of aligning projected customer needs with core competencies and resources and further investigating the customer needs based on the correlation is that it allows a user to quickly ascertain which customer needs the user can most efficiently

and cost-effectively optimize. It would have been obvious, at the time of the invention, for one of ordinary skill in the art to correlate projected customer needs with core competencies and resources and further investigate customer needs based on the correlation in order to select processes that can be efficiently and cost-effectively optimized, which is a goal of Ulwick (see column 2 lines 40-42).

As per claim 20, Ulwick teaches:

The method of claim 19, further comprising storing for later review unselected target projected customer needs (see figure 14, 15 and 17; where data storage is provided to store all actions taken by the user).

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following are pertinent to the current invention, though not relied upon:

Schofield et al. (U.S. Patent Publication Number 2002/0128938) teaches a computer implemented method for processing data representing transactions involving a plurality of commodities and one or more suppliers for each of the plurality of commodities.

Honarvar (U.S. Patent No. 6321206) teaches a software-based decision management system that allows an organization to monitor and evaluate client performance data relating to client interactions with the organization, and to appropriately modify organizational strategies in accordance with the performance data.

Nishikawa et al. (U.S. Patent No. 6937193) teaches a product design process and apparatus for quickly and easily defining an optimal product concept capable of conveying a high degree of customer satisfaction.

Flores et al. (U.S. Patent No. 5734837) teaches a method and system which provides consultants, business process analysts, and application developers with a unified tool with which to conduct business process analysis, design, documentation and to generate business process definitions and workflow-enabled applications.

Lackman et al. (Lackman, Conway; Saban, Kenneth; Lanasa, John; "The Contribution of Market Intelligence to Tactical and Strategic Business Decisions", *Marketing Intelligence to Tactical and Strategic Business Decisions*, 200, pp. 6-8) teaches the use of market data to create market intelligence for use in strategic and tactical decisions.

Goldenberg (Goldenberg, Barton; "Re-Engineering Sales & Marketing with Advanced Information Delivery Systems", *Sales & Marketing Management*, April 1995, pp. 1-31) teaches improving sales and marketing through the use of research data.

Dube et al. (Dube, Laurette; Renaghan, Leo M.; Miller, Jane M.; "Measuring Customer Satisfaction for Strategic Management", *Cornell Hotel & Restaurant Administration Quarterly*, February 1994, pp. 39-47) teaches customer satisfaction data to promote business sales.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kalyan K. Deshpande whose telephone number is (571) 272-5880. The examiner can normally be reached on M-F 8am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (571) 272-6729. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Susanna Diaz

SUSANNA M. DIAZ
PRIMARY EXAMINER

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Art 3623